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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,205	12/08/2004	Niclas Rosberg	P08510US00/MP	5622
881	7590	06/22/2007		
STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			EXAMINER TALBOT, MICHAEL	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 06/22/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/517,205

**Applicant(s)**

ROSBERG, NICLAS

**Examiner**

Michael W. Talbot

**Art Unit**

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 June 2007 has been entered.

### ***Claim Rejections - 35 USC § 102 & 35 USC § 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by WO 84/04367 or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 84/04367. WO 84/04367 shows in Figures 1-3 a hydro-mechanical chuck having one end for mounting in a machining device and having a second end for releasably holding a shaft (b) of a tool. WO 84/04367 shows the hydro-mechanical chuck comprising an inner sleeve (containing surface e) with an axial bore for receiving the shaft of the tool (Fig. 1) and an outer sleeve (containing surface f) enclosing at least one chamber (c) in which a clamping means in the shape of an annular piston

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(d) is enclosed. WO 84/04367 shows the piston by means of hydraulically operating means is displaceable in an axial direction (page 5, lines 13-20), wherein the piston and the inner sleeve have respective contacting and interacting conical surfaces with each other (page 5, lines 10-13), having a conicity that is self-locking (page 5, lines 24-26), whereby axial displacement of the piston in one direction causes radial displacement of the inner sleeve for clamping the shaft and axial displacement of the piston in another direction causes relief of the inner sleeve for releasing the shaft (page 5, lines 13-20). WO 84/04367 shows the chamber including a pressurized chamber (to the left side of piston d within chamber c as viewed in Fig. 1) and a relief chamber (to the right side of piston d within chamber c as viewed in Fig. 1). WO 84/04367 shows the inner sleeve (containing surface e) and outer sleeve (containing surface f) being joined together by welding (Fig. 1 at j, Fig. 3 at m,n and col. 7, lines 3-25). WO 84/04367 shows a sealing means in the shape of O-rings arranged between the piston and the outer sleeve (col. 5, lines 20-24). WO 84/04367 shows a part intended for clamping a tool is integrated with a part intended for mounting in a machining device (Figs. 1 and 3).

In the alternative, regarding claim 1, the phrase "a chuck having one end for mounting in a machining device and having a second end for releasably holding a shaft tool" does not further limit the claim and is merely a functional/intended use statement not defining any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, WO 84/04367 discloses a structure fully capable of having one end being connected to a machining device and a second end for releasably clamping a tool regardless as to how well it performs.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being anticipated by WO 84/04367 in view of Massa '048. WO 84/04367 lacks the hydro-mechanical chuck device functioning as an expandable mandrel/arbor to engage a tool or work piece.

Massa '048 shows in Figure 4 a hydro-mechanical mandrel (12') for expansion radially outwardly to engage the tool or work piece (col. 5, lines 23-41). In view of this teaching of Massa '048, it would have been obvious to modify the hydro-mechanical chuck of WO 84/04367 to function as an expandable hydro-mechanical mandrel as taught by Massa '048 to permit the accurate and repeatable positioning/clamping of larger sized tools or work pieces constructed with an internal bore.

***Response to Arguments***

6. Applicant's arguments, see pages 4-7, filed 14 June 2007, with respect to claims 1-7,9,10 and 12 have been fully considered and are persuasive. The rejection of claims 1-7,9,10 and 12 under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) with respect to references DE 3502362 and Firestone et al. '759 has been withdrawn.

7. Applicant's arguments filed 14 June 2007 have been fully considered but they are not persuasive with respect to reference WO 84/04367.

8. Examiner respectfully disagrees with Applicant's assertion that the 102 anticipatory prior art rejection recited above relies upon a non-analogous art. It has been held that arguments that the alleged anticipatory prior art is non-analogous or is not recognized as solving the

problem solved by the claimed invention, are not germane to a rejection under section 102. The question of whether or not a reference is analogous is not relevant to whether that reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be directed to an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims (MPEP 2131.05). In the case, WO 84/04367 shows a coupling with one end capable of being mounted in a machining device and another end capable of releasably holding a shaft (Figs. 1 and 2).

9. In response to applicant's argument that the claimed invention "provides for the avoidance of flexing in the tool mounting the machine" (Page 3, paragraph 1), "provides for forced reception during precision machining in order to avoid flexing in the tool mount of the machining device" (Page 3, paragraph 1), "consist of the fact that forced reception via the outer sleeve (the diameter of the outer sleeve allows a good moment reception and thereby a high rigidity against flexing) is obtained, while at the same time both a very good centering and balancing of the tool and a strongly clamped tool is obtained" (Page 3, paragraph 3 and Page 4, paragraph 1), and "provides a strong tool mount having a high flexural rigidity, thereby allowing it to withstand radial forces" (Page 4, paragraph 2), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, WO 84/04367 discloses a structure fully capable of having one end being connected to a machining device and a second end for releasably clamping a tool.

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**Conclusion**

10. In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT  
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20 June 2007



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